

REMARKS

By this Amendment, Applicant amends claims 37, 38, 41, 42, 44, and 45, and add new claims 46 and 47. Claims 37-47 are now pending in this application.

In the Office Action,¹ the Examiner rejected claims 37-44 under 35 U.S.C. § 103(a) as being unpatentable over O'Leary et al. (U.S. Patent No. 5,249,967) in view of Piater (WO 93/11519) and rejected claim 45 under 35 U.S.C. 103(a) as being unpatentable over O'Leary in view of Piater and in further view of Security CCTV, "Point-of Sale Monitoring Downsizes for Small Venues" ("Security").

I. REJECTION OF CLAIMS 37-44 UNDER § 103(a)

Applicant respectfully traverses the rejection of claims 37-44 under 35 U.S.C. § 103(a) as being unpatentable over O'Leary in view of Piater because a *prima facie* case of obviousness has not been established. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See MPEP § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See MPEP § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

MPEP § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See MPEP § 2143 (8th ed. 2001). In this application, a *prima facie* case of obviousness has not been established for at least the reason that the applied references fail to teach or suggest each and every element of the claims.

Independent claim 37, as amended, recites a method including, among other things, "obtaining real-time information related to the physical activity of the user, wherein the real-time information is extracted from the real-time signal of the user." O'Leary and Piater, whether taken alone or in combination, do not disclose or suggest at least this element of independent claim 37.

By contrast, in the O'Leary system, a student athlete may closely pattern his technique to a recognized master. See Abstract. In particular, video cameras transmit live images of a student athlete and a video overlay generator receives the live images and combines them with template images that show the recognized master. See id. Combining a template image of a master with a live image of a student, however, does not disclose or suggest "obtaining real-time information related to the physical activity of the user, wherein the real-time information is extracted from the real-time signal of the user," as required by independent claim 37.

Moreover, Piater does not compensate for the deficiencies of O'Leary. According to the Piater system, a "user can observe himself/herself during the swinging of a golf club." See page 6 of the translation of Piater. However, such a teaching does not constitute or suggest "obtaining real-time information related to the physical activity of the user, wherein the real-time information is extracted from the real-time signal of

the user,” as required by claim 37. Accordingly, since O’Leary and Piater, whether taken individually or in combination, do not teach or suggest all of the elements of claim 37, a *prima facie* case of obviousness has not been established. Therefore, for at least this reason, the Examiner should withdraw the rejection of claim 37 under 35 U.S.C. § 103(a), as well as the rejection of dependent claims 38-41, which depend from claim 37.

Independent claim 42, while of a different scope from claim 37, includes recitations of a similar scope as allowable claim 37. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 42 for at least the reasons given above. Therefore, the Examiner should withdraw the rejection of independent claim 42 under 35 U.S.C. § 103(a), as well as the rejection of dependent claims 43 and 44, which depend from claim 42.

II. REJECTION OF CLAIM 45 UNDER § 103(a)

Applicant respectfully traverses the rejection of claim 45 under 35 U.S.C. 103(a) as being unpatentable over O’Leary in view of Piater and in further view of “Security.”

Independent claim 45, as amended, recites a method including, among other things, “obtaining real-time information related to the physical activity of the user from a processor, wherein the real-time information is extracted by the processor from the real-time signal of the user” (emphasis added). O’Leary, Piater, and “Security,” whether taken alone or in any combination, do not disclose or suggest at least this element of claim 45.

As discussed above, O'Leary and Piater do not teach or suggest recitations of independent claims 37 and 42 that are similar to those of independent claim 45.

Moreover, "Security" does not compensate for the deficiencies of O'Leary and Piater.

By contrast, in the "Security" system, a video camera monitors a cashier and a "text inserter" superimposes register data from the register's RS-232 output over a video image. See "Security," column 1. Thus, "Security" teaches combining register data, which is output by the register, with a video image of a cashier. However, the register data is not extracted from the video image of the cashier. Rather, the register data is independently obtained from the register's RS-232 output. Therefore, "Security" does not teach or suggest "obtaining real-time information related to the physical activity of the user from a processor, wherein the real-time information is extracted by the processor from the real-time signal of the user," as required by independent claim 45 (emphasis added).

For at least the above reasons, "Security" does not compensate for the deficiencies of O'Leary and Piater and the applied references, whether taken individually or in combination, do not disclose or suggest all of the elements of independent claim 45. Therefore, the Examiner should withdraw the rejection of claim 45 under 35 U.S.C. § 103(a).

III. NEW CLAIMS 46 AND 47

New claims 46 and 47 depend from independent claims 42 and 45, respectively, and are not disclosed or suggested by the applied references, whether taken

individually or in combination, at least due to their dependence. Therefore, Applicant respectfully requests that the Examiner allow new claims 46 and 47.

CONCLUSION

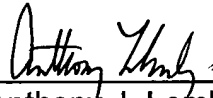
In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: August 23, 2006

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